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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,118	11/17/2003	Hajime Suda	008312-0306629	9773
909 7590 02/06/2008 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER SCHNURR, JOHN R	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 02/06/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/713,118		SUDA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	John R. Schnurr		2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :01/05/2006, 10/05/2005, 11/17/2003 and 08/23/2007.

### DETAILED ACTION

1. This Office Action is in response to the Amendment After Non-Final Rejection filed 11/20/2007. Claims 1, 2, 5-7 and 10 are pending and have been examined.
2. The information disclosure statements (IDS) submitted on 01/05/2006, 10/05/2005, 11/17/2003 and 08/23/2007 were considered by the examiner.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 2, 5-7 and 10 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments (Remarks page 7 para. 3 to page 8 para. 1) against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's arguments (Remarks page 8 para. 2 to para. 5) that Ellis (US PG-PUB 2005/0028208) does not teach or suggest a transmitting unit and a transferring unit, the examiner respectfully disagrees. Applicant indicates that Ellis teaches a remote device 24, which transmits requests to television equipment 22. Television equipment 22 then forwards the request to program guide server 25, which provides the television equipment 22 with program guide data. The program guide data is then transmitted from the television equipment 22 to the remote device 24. (Remarks page 8 para. 2) This clearly meets the claimed limitation of a transmitting unit which transmits the recording reservation data (EPG information [0024] of the Specification)

acquired from the information-providing site, to the information terminal via the communications unit.

Applicant further indicates that Ellis teaches an Internet service system 61, which allows a remote user to change settings, including program recording (Remarks page 8 para. 3). The Internet service system 61 allows the remote device 24 to obtain program guide information from the user television equipment 22. Remote device 22 establishes a session with Internet service system 61 to thereby obtain program guide data, e.g. program recording ([0097]). Internet service system 61 obtains the program guide information from user television equipment 22 directly ([0098]). The remote user may interact with the program guide data obtained via Internet service system 61, e.g. select a program for recording, and transmit the changed data back to the user television equipment 22 ([0099]-[0100]). This clearly meets the limitation of a transferring unit which transfers new recording reservation data transmitted from the information terminal via the communications unit, to the reservation-storing unit, the new recording reservation data being changed from the recording reservation data or containing data items added to the recording reservation data by the information terminal.

In response to applicant's argument that there is no suggestion to combine the references (Remarks page 9 para. 1 to para. 2), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation can be found in the references themselves. Ellis teaches a remote terminal may communicate with a home terminal for the benefit of enabling remote users to interact with the home terminal ([0005]).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **1, 2, 5-7 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kaizu et al. (US Patent Application Publication 2002/0097985)**, herein Kaizu, in view of **Ellis et al. (US Patent Application Publication 2005/0028208)**, herein Ellis.

Consider **claim 1**, Kaizu clearly teaches a digital video-data recording/reproducing apparatus, comprising:

a communications unit which is to be connected to a network and which communicates with an information-providing site for providing recording reservation data; (**Fig. 1: Personal computer 1 communicates with EPG server 7 via Internet 6, [0035] and [0039].**)

a reservation-storing unit (**Fig. 2 RAM 23**) which stores the recording reservation data provided from the network; (**[0126]**)

a data-acquiring unit which transmits a request for the recording reservation data to the information-providing site connected to the network, (**Fig 9: In step S24 the CPU 21 executing the browser 91 requests download of the preset recording data from EPG server 7, [0107]-[0108].**) acquires the recording reservation data provided from the

information-providing site, ([0108]) and transfers the recording reservation data to the reservation-storing unit. ([0126])

Kaizu further teaches that a mobile device, information terminal, maybe used to control the recording. ([0045])

However, Kaizu does not explicitly teach the information terminal communicating the request for the recording to the data-acquiring unit. Kaizu further does not explicitly teach a transmitting unit which transmits the recording reservation data acquired from the information-providing site, to the information terminal via the communications unit; and a transferring unit which transfers new recording reservation data transmitted from the information terminal via the communications unit, to the reservation-storing unit, the new recording reservation data being changed from the recording reservation data or containing data items added to the recording reservation data by the information terminal.

In an analogous art, Ellis, which discloses a system for remotely accessing an electronic program guide, clearly teaches communicating a request for recording from an information terminal to a data-acquiring unit. **(Fig. 6a: Remote program guide access device 24 may communicate via Internet service system 61 with the user television equipment 22 to request a program recording, [0099]-[0100].)** Ellis further teaches a transmitting unit which transmits the recording reservation data acquired from the information-providing site, to the information terminal via the communications unit; **(Remote device 24 transmits requests to television equipment 22. Television equipment 22 then forwards the request to program guide server 25, which provides the television equipment 22 with program guide data. The program guide data is then transmitted from the television equipment 22 to the remote device 24, [0074].)** and a transferring unit which transfers new recording reservation data transmitted from the information terminal via the communications unit, to the reservation-storing unit, the new recording reservation data being changed from the recording reservation data or containing data items added to the recording reservation data by the information terminal. **(Remote device 22 establishes a session with Internet service system 61 to thereby obtain program guide data, e.g. program recording ([0097]). Internet service system 61 obtains the program guide information from user television equipment 22 directly ([0098]). The remote user may interact with the program guide data obtained via Internet service system 61, e.g. select a program for recording, and transmit the changed data back to the user television equipment 22 ([0099]-[0100]))**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Kaizu by allowing a

remote terminal to obtain program guide data from a home terminal and send a request for recording to the home terminal, as taught by Ellis, for the benefit of allowing the user to interact with a set-top box without being physically located near the set-top box ([0005] Ellis).

Consider **claim 2**, Kaizu combined with Ellis, as in claim 1, clearly teaches the data-acquiring unit generates and transmits data-acquisition data to the information terminal via the communications unit after acquiring the recording reservation data, **(Program guide data or display screens can be forwarded to remote program device 24 from user television equipment 22, [0074] Ellis.)** the data-acquisition data indicating that the data-acquiring unit has acquired the recording reservation data. **(Fig. 15 [0128])**

Consider **claim 5**, Kaizu combined with Ellis, as in claim 1, clearly teaches the network is the Internet, **(Fig 1: Internet 6, [0035] Kaizu)** the recording reservation data is electronic program guide information, **(Fig. 1: Recording information is downloaded from EPG server 7, [0036] Kaizu.)** the information terminal is connected to the Internet, **([0097] Ellis)** the information-providing site is connected to the Internet and provides electronic program guide information, **(Fig. 1: EPG server 7 is connected to the Internet 6, Kaizu.)** and the data-acquiring unit acquires the electronic program guide information by downloading the same, **(Fig 9: In step S24 the CPU 21 executing the browser 91 requests download of the preset recording data from EPG server 7, [0107]-[0108] Kaizu.)** in response to a request made by the information terminal. . **(Fig. 6a: Remote program guide access device 24 may communicate via Internet service system 61 with the user television equipment 22 to request a program recording, [0099]-[0100] Ellis.)**

Consider **claim 6**, see claim 1.

Consider **claim 7**, see claim 2.

Consider **claim 10**, see claim 5.

#### **Conclusion**

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).




A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Schnurr whose telephone number is (571) 270-1458. The examiner can normally be reached on Monday - Friday, 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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